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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,697	03/01/2002	Richard Franz	D-2998	4890
33197	7590	07/28/2005	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP			SANDERS JR, JOHN R	
4 VENTURE, SUITE 300			ART UNIT	
IRVINE, CA 92618			PAPER NUMBER	

3737

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/087,697	<b>Applicant(s)</b> FRANZ ET AL.	
	<b>Examiner</b> John R. Sanders	<b>Art Unit</b> 3737	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-4, 6-16, 18-25, 28, 29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6-16, 18-25, 28, 29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 09 May 2005 have been fully considered but they are not persuasive. See Remarks after the §103(a) rejection, reproduced from the previous Action.

### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. **Claims 2-4, 6-16, 18-25, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy, of record, in view of U.S. Patent No. 6,112,224 to Peifer et al. ("Peifer"), and further in view of U.S. Patent No. 6,080,106 to Lloyd et al. ("Lloyd").**

#### *Kennedy in view of Peifer:*

3. Kennedy discloses a system and method for eye screening (FIG. 7) wherein a remote exam module (composed of a device to record corneal and retinal reflections, a data entry device, and a control system) collects eye images from the patient. This information is transmitted to the central analysis facility via a communication link (col. 6, line 57 - col. 7, line 6). The central analysis facility comprises a record database and means for displaying the images for skilled specialists (col. 2, line 47- col. 3, line 10; col. 7, line 31- col. 8, line 11).

4. Kennedy does not necessarily or expressly disclose a plurality of different examination devices or the central analysis facility directing the examination.

5. Peifer discloses a remote exam module **50** comprising a plurality of medical devices **21-23**, a control unit **11** and interface **17** for controlling the medical devices to obtain diagnostic

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measurements of a patient (fig. 2). Peifer discloses monitoring stations **54**, **56**, and **58** that send command information to said remote modules and act as analysis centers for receiving information from the medical devices (col. 6, lines 26-34). Peifer discloses the patient and the health care professional communicating through network **52** “via any one or more combinations of voice, video and data.” Peifer discloses the remote exam module having medical devices “implemented in numerous ways including, but not limited to, blood pressure devices, thermometers, pulse oximetry devices, electrocardiograms (EKGs), scales, stethoscopes, or any other diagnostic or data acquisition equipment.” (col. 4, lines 34-38).

6. Kennedy and Peifer are analogous art as they are both directed expressly to remote medical examinations and communications between an analysis center and remote examination modules. One of ordinary skill in the art would have found it obvious to combine Kennedy and Peifer to arrive at Applicant’s invention.

7. Firstly, where Kennedy does not expressly disclose a plurality of examination devices in the remote module or the central analysis facility directing the medical devices, Peifer expressly teaches multiple medical devices in remote system **50** being remotely operable by a monitoring station **54**.

8. Secondly, where Kennedy does not expressly disclose real-time teleconferencing, Peifer teaches one or more combinations of voice, video, and data, which, by the standard of the current state-of-the-art usage of Internet resources, would obviously be conducted in real-time and inherently require the use of an exam console.

9. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the disclosure of Kennedy to include examination with a plurality of eye examination

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instruments in order to collect multiple eye measurements, as well as to remotely control said instruments as taught by Peifer, the reasons and motivations for doing so discussed above and in further detail by both references.

10. Regarding claims 4 and 25 the system of Kennedy is capable of obtaining information relating to both retinal and corneal reflections, i.e. fundus information, retinal information, corneal topography, and refraction information.

11. Regarding claims 7-9, Kennedy discloses remote data entry via a touch screen and/or voice recognition (col. 8, lines 12-38) and a questionnaire (col. 14, lines 2-5).

12. Regarding claims 10, 15 and 24, Kennedy discloses posting relevant patient information on the web (col. 7, lines 2-6).

13. Regarding claim 11, digital signals are inherent as a part of Internet data transmission.

14. Regarding claim 13, 14 and 21, Kennedy discloses creation and retrieval of examination records (col. 7, lines 14-21). It is obvious to update a patient record to reflect newly acquired information, as the purpose of a patient record is to contain an up-to-date history of the patient's examinations.

15. Regarding claim 16 and 22, Kennedy discloses sending a report to the patient via the communication link (col. 2, lines 47-65).

Further in view of Lloyd:

16. Peifer discloses a monitoring station and the acquisition and control of data to and from said monitoring station, and Kennedy discloses a patient record database (remotely accessible by a health care profession located at a monitoring station) and record manipulation techniques as

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previously discussed, but neither expressly discloses a patient record database located at the monitoring station.

17. Lloyd teaches a remote patient interface connected via communication link **60** to a monitoring station **70** comprising an exam console and patient database/data archive (fig. 1).

18. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Kennedy in view of Peifer to include a patient database located at the examiner's location as taught by Lloyd, in order for the examiner to have immediate access to the data.

19. **Claims 2-4, 6-16, 18-25, 28-29, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peifer in view of Kennedy, of record, and further in view of Lloyd.**

20. It is possible for the proceeding rejection to be restated as a modification of Peifer in view of Kennedy. Peifer discloses the above limitations but does not expressly disclose the medical devices **21-23** as being eye examination devices or the central monitoring stations **54**, **56**, and **58** remotely commanding the medical devices to perform specifically an eye examination.

21. In this case, it would have been obvious to modify Peifer to include eye examination apparatuses as the medical devices and modify the monitoring stations to control the eye examination, as taught by Kennedy.

22. It would also have been obvious to one of ordinary skill in the art to modify the patient and central monitoring stations Peifer to include the further limitations to Kennedy and Lloyd as described above.

**REMARKS**

Regarding Kennedy:

23. Applicant asserts that Kennedy fails to anticipate and in fact teaches away from the limitation of an exam console located at a diagnostic center where the practitioner views the exam information. Examiner respectfully disagrees.

24. Applicant argues that the primary distinction between the instant invention and the prior art resides in the fact that, whereas in the instant invention the practitioner analyzes the exam data acquired by the remote exam module at a diagnostic center, Kennedy teaches that the practitioner is at a reading center that is remote from a central analysis facility. Examiner respectfully disagrees with Applicant's assertion that Kennedy necessarily teaches away.

25. It may be of use to explore the broadest interpretation of the limitation *remote* in view of the general knowledge of the art. With the advent of computer networking and Internet communications, the ability to transmit data substantially instantaneously across large distances has redefined the concept of *remote* operation. It would be to one of ordinary skill in the art that a remote communication could equally apply to a communication sent across an ocean, from coast to coast, across town, between rooms in a building, or even between computers located in the same room. In truth, the instant specification states, with regard to the remote exam module and the diagnostic center, "The examination site is generally remote from the diagnostic center, however it can be appreciated that the remoteness of the location may comprise the distance of a room, or may include a distance of many thousands of miles" (page 4, first paragraph). Obviously, Applicants are aware of the broad interpretation of *remote* and how it applies to telecommunications.

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26. Examiner submits that one of ordinary skill in the art would be apprised that the reading centers disclosed by Kennedy could in fact be located in the same building or even the same room as the central analysis facility and could therefore be said to be located at the central analysis facility and therefore cannot be said to teach away from Applicant's invention.

Regarding Peifer:

27. Applicant asserts that as Peifer merely discloses non-ophthalmic monitoring equipment, Peifer does not teach or suggest a remote exam module comprising multiple eye examination devices. Applicant asserts that Peifer only teaches "monitoring" of the patient and therefore does not teach conducting an eye examination. Peifer allows that "any other diagnostic or data acquisition equipment" may be implemented as the disclosed medical devices (col. 4, 34-38). Examiner has provided Peifer as a showing that remotely sending commands to multiple medical devices is known in the art. Though Examiner concedes that conducting an eye examination is different than merely monitoring a patient, one of ordinary skill would be apprised of the nature of an eye examination, that other than merely controlling the equipment the practitioner needs to interact with the patient. To this end, both Kennedy and Peifer disclose real-time teleconferencing.

28. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.



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1992). In this case, one of ordinary skill in the art, with knowledge of the disclosures of Kennedy and Peifer, would have found it obvious that the exam modules of Kennedy could be modified to incorporate multiple exam devices and that said exam devices could be remotely controlled, as in Peifer.

Regarding Lloyd:

29. Examiner has provided Lloyd merely as a showing that, if not already obvious to one of ordinary skill in the art, a patient database containing exam data can be located at the same location as where the exam is being conducted, as this limitation is not expressly stated in the other applied references. Applicant's assertion that, since Lloyd discloses a nurse and not someone capable of providing diagnoses, Lloyd teaches away from the instant invention is irrelevant since Lloyd does in fact teach a patient database located where the exam is being conducted. A physician would not be precluded from using the system disclosed by Lloyd.

30. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

At the time of the invention, one of ordinary skill in the art of ophthalmology would not be precluded from contemplating the application of the cited telemedicine references to his or her

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field of medicine since the information disclosed by the references is directly applicable to any field where it is desired to perform remote diagnostics on a patient.

### ***Conclusion***

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

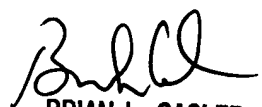
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (571) 272-4742. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (571) 272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
July 25, 2005

  
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